

Remarks

Upon entry of the foregoing amendment, claims 1-4, 6, 7 and 12-17 are pending in the application, with claim 1 being the sole independent claim. Claims 5 and 8-11 are cancelled.

Claims 2-4, 6 and 7 have been amended. Claims 2 and 4 have been amended to better conform with U.S. practice. Claims 3, 6 and 7 have been added to better define Applicants' claimed inventions. Support for amendment to claim 7 can be found in specification as filed on page 60, lines 5-7. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendments, Applicants respectfully submit that present claims 1-4, 6, 7 and 12-17 are in condition for allowance.

I. Supplemental Information Disclosure Statement

Applicants note that a Third Supplemental Information Disclosure Statement is submitted accompanying the Supplemental Amendment and Reply. Applicants respectfully request the Examiner initial and return a copy of Information Disclosure Statement Forms.

II. Statement of Substance of Interview Held on January 5 and January 8, 2010

Applicants wish to thank Examiner Rodriguez-Garcia for helpful phone interviews held on January 5 and January 8, 2010. The allowable subject matters were discussed as well as proposed amendments to claims 4, 6 and 7. During the interview on January 5, 2010, the Examiner has indicated that claims 3, 6 and 7 will be rejoined upon the entry of amendments to claims 6 and 7. During the interview on January 8, 2010, the

Examiner has indicated that the non-statutory obviousness-type double patenting rejection over claims 1-4 and 7-8 of U.S. Patent No. 7,208,169 B2 has been withdrawn; and the provisional non-statutory obviousness-type double patenting rejections over co-pending Application Nos. 10/538,242 and 12/097,753 have been withdrawn.

III. Rejoinder

Claims 3, 6 and 7 were previously withdrawn from consideration by the Examiner. During a phone interview with Applicants' representative on January 5, 2010, the Examiner has indicated that claims 3, 6 and 7 will be rejoined upon the entry of amendments to claims 6 and 7.

IV. Nonstatutory Obviousness-type Double Patenting Rejections

A. Rejection over U.S. Patent No. 7,208,169

Claims 1, 2 and 4 are rejected on the ground of non-statutory obviousness-type double patenting over claims 1-4 and 7-8 of U.S. Patent No. 7,208,169 B2. Applicants respectfully traverse this rejection.

During a phone interview with Applicants' representative on January 8, 2010, the Examiner has indicated that this rejection has been withdrawn.

B. Provisional Obviousness-type Double Patenting Rejections

Claims 1, 2 and 4 were provisionally rejected on the ground of non-statutory obviousness-type double patenting over claims 15-26 of co-pending Application No. 10/538,242; claims 1-4 of co-pending Application No. 10/579,033; claims 1-4 of co-

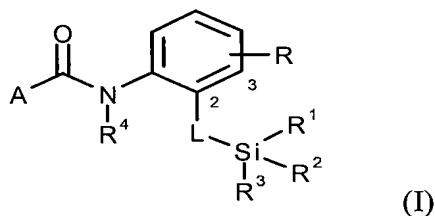
pending Application No. 10/597,723; and claims 1-4 of co-pending Application No. 12/097,753. Applicants respectfully traverse these rejections.

During a phone interview with Applicants' representative on January 8, 2010, the Examiner has indicated that the rejections over co-pending Application Nos. 10/538,242 and 12/097,753 have been withdrawn. With respect to the rejections over co-pending Application Nos. 10/579,033 and 10/597,723, Applicants respond as follows.

(a) Rejection over Application No. 10/579,033

U.S. Appl. No. 10/579,033 issued as U.S. Patent No. 7,598,389 B2 ("the '389 patent") on Oct. 6, 2009 with 15 claims, with claim 1 being the sole independent claim. Claim 1 of the '389 patent is reproduced below:

1. Silylated carboxamides of the formula (I)



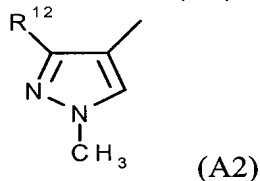
in which

R is hydrogen, fluorine, chlorine, methyl, isopropyl, methylthio or trifluoro-methyl,

L is a direct bond or is in each case optionally substituted straight-chain or branched alkylene (alkanediyl), alkenylene (alkenediyl) or alkynylene (alkyndiyl),

* * *

A is the radical of the formula (A2)

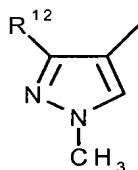


in which

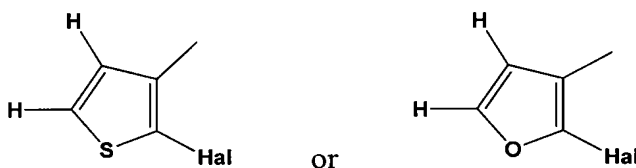
R¹² is chlorine or iodine.

The '389 patent, col. 39, line 2 through col. 40, line 15.

Thus, claims 1-4 of the '389 patent require silylated carboxamides having an "A" group being



In contrast, the present claims 1, 2 and 4 require 2-halofuryl/thienyl-3-carboxamides having the corresponding "A" group being



Thus, claims 1, 2 and 4 of the present application are directed to completely different compounds than those of recited in claims 1-4 of the '389 patent. Moreover, the Examiner has not provided adequate reasons why a person of ordinary skill in the art would have modified the compounds of claims 1-4 of the '389 patent to arrive at presently claimed compounds.

Thus, for at least these reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection over claims 1-4 of the '389 patent.

(b) Rejection over Application No. 10/597,723

Solely to expedite allowance of the claims, and not in acquiescence to the Examiner's rejection, Applicants submit herewith a Terminal Disclaimer under 37 C.F.R.

§ 1.132(c) over the Application No. 10/597,723. Accordingly, this rejection has been overcome. Thus, Applicants respectfully request that the rejection be withdrawn.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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